



1764

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Thomas Schwalbe et al. Attorney Docket No: CELL0013
Serial No: 09/578,224 Group Art Unit: 1764
Filed: May 24, 2000 Examiner: Leung, Jennifer A.
Title: MODULAR CHEMICAL PRODUCTION SYSTEM INCORPORATING A
MICROREACTOR

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ELECTION TRANSMITTAL LETTER

Bellevue, Washington 98004

February 7, 2003

TO THE DIRECTOR OF THE PATENT AND TRADEMARK OFFICE:

Transmitted herewith is an election in the above-identified patent application. No additional claim fee is required, as shown below. Please charge any additional fees or credit any overpayment to Deposit Account No. 01-1940. A copy of this sheet is enclosed.

| <u>Computation of Fee For Claims as Amended</u> | | | | | |
|---|---|---|----------------------|-------------|---------------------------|
| | <u>Claims Remaining after Amendment</u> | <u>Highest Number Previously Paid For</u> | <u>Present Extra</u> | <u>Rate</u> | <u>Additional Fee</u> |
| Total Claims | 71 | 71 | -0- | x \$9 | -0- |
| Independent Claims | 7 | 7 | -0- | x \$42 | -0- |
| TOTAL ADDITIONAL FEE FOR THIS AMENDMENT | | | | | -0- |

Respectfully submitted,

Ron Anderson

Ronald M. Anderson
Registration No. 28,829

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Director of Patents and Trademarks, Arlington, VA 22202, on February 7, 2003.

Date: February 7, 2003

Kathy Paine



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Serial No: 09/578,224 Group Art Unit: 1764
Filed: May 24, 2000 Examiner: Leung, Jennifer A.
Title: MODULAR CHEMICAL PRODUCTION SYSTEM INCORPORATING A
MICROREACTOR
ELECTION IN RESPONSE TO A RESTRICTION REQUIREMENT

Bellevue, Washington 98004

February 7, 2003

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TO THE DIRECTOR OF THE PATENT AND TRADEMARK OFFICE:

The following is in response to an Office Action dated January 10, 2003, in which the Examiner restricted the above-identified patent application. The Examiner has indicated that this application contains claims directed to two groups of patentably distinct inventions.

The Examiner indicates that Claims 1-62 and 70-71 (Group I) are directed to a modular systems for reacting chemicals, while Claims 63-69 (Group II) are directed to a method for processing a plurality of reactants. The Examiner further asserts that the claims in Group I define three patentably distinct inventions, namely, Invention IA, which is defined by Claims 1-26 and 71; Invention IB, which is defined by Claims 27-29; and Invention IC, which is defined by Claims 30-62 and 70.

Applicants affirmatively elect, with traverse, Group I, Invention IA (i.e. Claims 1-26 and 71). The restriction is traversed for the following reasons.

MPEP 803 clearly states that "[I]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." The Examiner has indicated that Inventions IA, IB, and IC are *all* classified in Class 422, subclass 188. Regardless of the merits of the Examiner's position that the claims of Inventions IA-IC define distinct inventions, because the classification of the three inventions is the same, it is clear that examining the three inventions together would not represent an additional or serious burden on the Examiner.

The Examiner has asserted that not only do Inventions IA-IC each represent a patentably distinct invention, each also has acquired a *separate status* in the art due to their divergent

1 subject matter. While the combination/sub-combination explanations provided by the Examiner
2 are relevant to establishing distinctiveness, the Examiner has presented no evidence that
3 Inventions IA-IC have acquired a separate status in the art. According to MPEP 803,
4 distinctiveness alone with respect to groups in the same classification does not justify issuing a
5 restriction. MPEP 803 further refers to MPEP 808.02 for guidelines in establishing a *prima facie*
6 showing that a serious burden exists, and providing evidence that a restriction is proper.

7 With respect to inventions that are classified separately, MPEP 808.02 indicates that
8 different classifications in and of themselves are sufficient to show that each distinct subject has
9 attained recognition in the art as a separate subject for inventive effort, and also a separate field
10 of search. However, with respect to groups that are classified identically (i.e., Inventions IA-IC
11 in the pending application), MPEP 808.02 suggests that patents should be cited by the Examiner
12 as evidence indicative that the inventions have achieved a separate status, and as evidence that
13 such inventions will require a separate field of search. No such evidence has been provided; the
14 arguments that have been provided appear to be directed to the issue of distinctiveness alone.

15 MPEP 808.2 defines different fields of search in the following manner:

16 Where it is necessary to search for one of the distinct subjects in places
17 where no pertinent art to the other subject exists, a different field of search
18 is shown, even though the two are classified together. The indicated
19 different field of search must in fact be pertinent to the type of subject
matter covered by the claims.

20 MPEP 808.02 concludes with the statement that when "...the classification is the same and the
21 field of search is the same and there is no clear indication of separate future classification and
22 field of search, no reasons exist for dividing among related inventions."

23 The Examiner has indicated that Inventions IA-IC are identically classified. While
24 presenting an explanation of why Inventions IA-IC are distinct inventions, the record does not
25 support a conclusion that Inventions IA-IC require a different field of search, or have achieved a
26 separate status in the art. Further, MPEP 808.02 plainly states that absent a clear indication of
27 separate future classification and field of search, no reason exists for a restriction. Applicants
28 respectfully submit that restriction between Inventions IA-IC is not proper. It appears that each
29 of Inventions IA-IC can be searched at the same time without any serious burden on the
30 Examiner. It further appears that it would be more efficient to do so, rather than requiring such

1 closely related inventions to be searched and prosecuted in different applications. Accordingly,
2 applicants respectfully request that the Examiner withdraw the restriction in regard to the claims
3 corresponding to Inventions IA-IC and examiner all of those claims (i.e., Claims 1-62, 70,
4 and 71) in the present application.

5
6 Respectfully submitted,

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9 Ronald M. Anderson
10 Registration No. 28,829

11 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a
12 sealed envelope as first class mail with postage thereon fully prepaid addressed to: Director of Patents
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13 Date: February 7, 2003
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